

REMARKS**I. Claim Amendments**

Applicant has amended claims 1, 14, 15, 21, and 36. In particular, applicant has amended claims 14 and 15 to correct typographical errors and claim 21 to incorporate subject matter of claim 24 (now canceled). Claim 36 has been amended so that an aspect of the preamble is now recited in the claim body. In addition, claim 1 has been amended to recite "monitoring conditions on the network for any change that would indicate a need for the client computer to have new configuration settings that client computers on the network require to engage in real-time communication over the network," support for which can be found in the Specification as filed at page 8, lines 5-10.

Applicant has canceled claims 24 and 31-35.

II. Claim Objections

Applicant has added a period at the end of claim 15 to address the Examiner's objection.

III. Rejections Under 35 U.S.C. § 112

Applicant has amended claim 14 to depend from claim 9 (as opposed to claim 8). The need for this amendment resulted from a typographical error. Now that the numbering has been corrected, the claim does not lack proper antecedent basis. Accordingly, applicant respectfully requests that the rejection under 35 U.S.C. § 112 be withdrawn.

IV. Rejections Under 35 U.S.C. § 102 and 35 U.S.C. § 103

The Examiner rejects claims 1, 2, 4, 5, 8, 15, 17, 18, 21, 23-25, and 30-35 under 35 U.S.C. § 102(e) as being anticipated by Giordano (US 6,370,141). The Examiner rejects claims 3, 6, 7, 9-14, 16, 19, 20, 22, 26-29 and 36 under 35 U.S.C. § 103. Applicant respectfully traverses these rejections.

Giordano describes a system where an Internet Compatible telephone can connect to a Web site containing configuration information for the telephone. The telephone can access an HTML page on the Web site that is used to configure the telephone. The telephone can download information from the HTML page to reconfigure its options or settings automatically. In addition, the Web site can include an upgrade Web page that includes information that alerts the user when the HTML page contains new information regarding changes to options and settings. It is possible for the user of the telephone to receive notification regarding particular options or settings or notification of all changes to the options or settings. The telephone may be automatically reconfigured with changes or reconfigured at the user's discretion.

A. *Claims 1, 15, and 30 (and Their Corresponding Dependent Claims)*

Claim 1 recites, among other claim elements, "monitoring conditions on the network for any change that would indicate a need for the client computer to have new configuration settings that client computers on the network require to engage in real-time communication over the network." Similarly, claim 15 recites a "server computer executing one or more programs for performing steps comprising monitoring the database, detecting whether or not a configuration setting on the database has changed to a new configuration setting, and in response to the detecting step, transmitting the new configuration setting to the client computer over the computer network" and claim 30 recites "a means for monitoring conditions on the network to determine whether any changes have occurred that would require the client computer to have new configuration settings in order to engage in real-time communication over the network."

As is known, to anticipate a claim under 35 U.S.C. § 102, the reference must teach every element of the claim. However, Giordano does not describe each one of applicant's claimed elements. For example, Giordano does not disclose monitoring either network conditions or a database. While Giordano's system may include an "upgrade Web page that includes information that alerts the user when the HTML page contains new

information regarding changes to options and settings," an "upgrade Web page" is simply not the same as monitoring a network or monitoring a database for changes. Giordano simply does not describe any type of monitoring. For at least these reasons, applicant respectfully requests that the rejections of claims 1, 15, 30 and their dependents be withdrawn.

B. Claims 21 and 25 (and Their Corresponding Dependent Claims)

Claim 21 recites, among other claim elements, a client computer transmitting "a request for the configuration settings that the client computer needs in order to engage in real-time communication over the computer network, including configuration settings that the client computer needs for the purpose of regulating access to a user by certain other users." Similarly, claim 25 recites "transmitting, to a server computer, a request for configuration settings required by the client computer to control real-time communication access to a user of the client computer." In this way, the claimed method provides a way to, for example, control/regulate such things as whether a user is allowed to monitor another user's "presence" (i.e. determine whether they are logged onto the network and what their network address is), whether a user is permitted to call another user via internet telephony, whether a user is to be prompted before allowing someone to monitor him or her, and the like.

While Giordano describes configuring an Internet-compatible telephone having settings including "telephone numbers for dialing in to the ISP network, users names, profile information, local default pages, as well as settings for handling connecting and disconnecting, time outs, and special calling features related to the telephone portion of the appliance, such as call waiting and call forwarding," Giordano does not describe every one of applicant's claim elements. For example, Giordano does not disclose a client computer that requests configuration settings that the client computer needs for controlling real-time communication access to a user of the client computer or regulating access to a user by certain other users. In addition, none of the other cited references disclose this. For at

least the reason that applicant's claimed request for specific configuration settings are not disclosed in Giordano, applicant respectfully requests that the rejection of claims 21 and 25 (and their dependents) be withdrawn.

C. *Claim 9 (and its Corresponding Dependent Claims)*

The Examiner rejects claim 9 (and its dependents) under 35 U.S.C. § 103 as being unpatentable over Giordano (US 6,370,141). Applicant respectfully traverses this rejection.

Claim 9 recites "maintaining a profile for the user, wherein the profile comprises information as to how to configure the client computer to perform real-time communication on the network," "receiving, from a client program executing on the client computer, a message formatted according to a real-time communication protocol, wherein the message includes a request for the profile," and "transmitting, over the computer network, at least part of the profile to the client computer." Accordingly, claim 9 is very specific as to the fact that a specific type of user profile is maintained, that the client sends a request for the profile via a specifically formatted message, and that the profile is sent to the client. None of this is taught or suggested in Giordano.

In support of the Section 103 rejection, the Examiner refers to column 1, lines 55-60 of Giordano (Background Section) which describes a user interface function relating to "displaying . . . user profile configuration information, such as how to dial, local area code, and the user's name, address, and zip code" and then asserts that "Giordano's system already stored the profiles at the client devices, but it would be a clear extension of Giordano's system to store the profiles at a different location." (Office Action at page 16, paragraph 27.) This, however, is not enough to support a *prima facie* case of obviousness. For example, while Giordano describes a user interface function relating to displaying user profile information, Giordano discloses neither maintaining user profile information nor requesting/transmitting profile information. A brief mention of a display of profile information in the Background Section combined with the Examiner's assertion that the

subject matter of applicant's claim 9 would be "a clear extension of Giordano's system" is simply not enough to support an obviousness rejection.

D. Claim 36

The Examiner rejects claim 36 under 35 U.S.C. § 103 as being unpatentable over Giordano (US 6,370,141) in view of Rosenberg et al. "An XML Format for Presence Buddy Lists." Applicant respectfully traverses this rejection.

Claim 36 recites "transmitting, to a server on the network, a request to be notified whenever changes are made to the access control list, wherein the access control list indicates the extent to which other users of the network may contact the associated user" and "receiving from the server computer, in response to the request, a document containing updates to the access control list." Neither Rosenberg nor Giordano, whether alone or in combination, disclose these claim elements. While the Examiner states that Rosenberg discloses buddy lists, the Examiner does not explain where Rosenberg discloses access control lists. Rosenberg's buddy lists are not the same as applicant's access control list, in that they do not specify the extent to which other users of the network may contact the associated user. Instead, a buddy list, as defined by Rosenberg, is "a list of other users a particular user would like to subscribe to." Moreover, Giordano does not teach any configuration settings relating to controlling access to a user of a communication network.

In view of the above amendment and at least for the reasons stated above, applicant maintains that all of the now-pending independent claims in the application, including claim 1, 9, 15, 21, 25, 30, and 36 are allowable and that the claims that depend from these claims are also allowable. Accordingly, applicant believes the pending application is in condition for allowance.

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